

### **REMARKS**

Claims 8-13, 16, and 18-22 are now present in the case. Consideration of the application in view of the following remarks is respectfully requested.

#### **Amendments to the Specification**

The amendments made to the paragraph beginning on page 46, line 27, were made to properly reference items labeled in the Figure 20. No new matter is introduced as a result of the amendments.

#### **Amendments to the Claims**

The amendments made to Claims 8 and 10 were made to correct antecedent basis noticed by Applicant during prosecution. No new matter is introduced as a result of the amendments.

#### **Claims Withdrawn**

In the Office Action mailed December 6, 2004, the Examiner withdrew Claims 6, 7, 14, 15, and 17 from consideration.

#### **Regarding Claims 6-7 and 14-15:**

The Examiner stated:

Claims 6,7 and 14-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed 08/30/2004.

Applicant acknowledges the withdrawal of Claims 6-7 and 14-15 from consideration, as being drawn to a non-elected invention.

### Regarding Claim 17:

The Examiner stated:

3. Newly submitted claim 17 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper. This situation can be diagrammed as combination AB<sub>br</sub> ("br" is an abbreviation for "broad"), and subcombination B<sub>sp</sub> ("sp" is an abbreviation for "specific"). B<sub>br</sub> indicates that in the combination the subcombination is broadly recited and that the specific characteristics set forth in the subcombination claim B<sub>sp</sub> are not set forth in the combination claim. Since claims to both the subcombination and combination are presented and assumed to be patentable, the omission of details of the claimed subcombination B<sub>sp</sub> in the combination claim AB<sub>br</sub>, evidence that the patentability of the combination does not rely on the details of the specific subcombination. In the instant application, B<sub>sp</sub> corresponds to claims 813 and AB<sub>br</sub>, corresponds to claim 17.

4. Applicant was expressly elected B<sub>sp</sub>, the reply filed on 08/30/2004, accordingly, claim 17 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant has canceled Claim 17.

### **Claim Rejections – Double Patenting**

Claims 8-13 and 16 were rejected as being unpatentable over Claims 1-2 of U.S. Patent No. 6,594,752, issued to Michael A. Baxter ("Baxter").

The Examiner stated:

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 8-13 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,594,752. Although the conflicting claims are not identical, they are not patentably distinct for the rationale set forth below.

7. 6,594,752 corresponds to the claims in the instant application as follows: receiving a data packet (claim 1, lines 1-4); decoding the data packet into a geographic address and a local address (claim 2, lines 3-4); comparing the geographic address to an associated geographic address (claim 2, lines 913); and responsive to the geographic address matching to the associated geographic address (claim 2, lines 413 ); transmitting the data packet to the local processor (claim 2, lines 11-13).

Applicant assumes Examiner meant "Claims 8-13 and 16" rather than "Claims 8-13 and 17" in paragraph numbered "6" above.

Applicant respectfully traverses the double-patenting rejection of Claims 8-13 and 16, on the grounds that the rejection was improperly made in this instance. 35 U.S.C. § 121 prohibits a double patenting rejection "where the Office has made a requirement for restriction." MPEP § 804.01. In particular, MPEP § 804.01 states:

The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on a application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent.

MPEP § 804.01 further states:

The prohibition against holdings of double patenting applies to requirements for restriction between the related subjects treated in MPEP § 806.04 through § 806.05(i), ...so long as the claims in each application are filed as a result of such requirement [for restriction].

The Baxter patent (No. 6,594,752; Appl. No. 09/255,499; hereinafter referred to as "Baxter Patent '752"), which was used as the basis of the instant double-patenting rejection, was issued from an application in which a requirement for restriction was made. The restriction

requirement in Baxter Patent '752, based on MPEP § 806.05(d), was made during prosecution of Baxter Patent '752 in an Office Action dated 09/27/01. Four "Inventions" were identified, corresponding to Claims 1-5, 6-7, 8-13, and 14-15. During prosecution of Baxter Patent '752, Applicant elected Claims 1-5, which ultimately became Baxter Patent '752, in the reply dated 10/26/01. The Notice of Allowance for Claims 1-5 was dated 03/28/03. Baxter Patent '752 issued on 07/15/03.

The application under consideration is a divisional of Baxter Patent '752, filed as a result of the restriction requirement made during prosecution of Baxter Patent '752. This application was filed on 07/10/03, prior to the issuance of Baxter Patent '752. As indicated in the Preliminary Amendment also filed on 07/10/03, "This application is a divisional application of Serial No. 09/255,499 [Baxter Patent '752] entitled: "META-ADDRESS ARCHICHITECTURE FOR PARALLEL, DYNAMICALLY RECONFIGURABLE COMPUTING", filed on February 23, 1999." The instant divisional application is directed to claims unexamined during the prosecution of the parent Baxter Patent '752.

Thus, since the instant divisional application was filed before the issuance of Baxter Patent '752, and was filed as a result of the restriction requirement based on MPEP § 806.05(d) made during prosecution of Baxter Patent '752, Applicant respectfully submits that the double-patenting rejection of Claims 8-13 and 16 using Baxter Patent '752 as a reference was improperly made. In addition, Applicant respectfully submits that since the double-patenting rejection was improper, a terminal disclaimer is not needed to overcome the rejection.

### CONCLUSION

In summary, Claims 8-13, 16, and 18-22 are present in this case. In view of the foregoing arguments, Applicant respectfully submits that Claims 8-13 and 16 are patentably distinguishable over all of the art of record. Therefore, Applicant requests reconsideration of the basis for the rejections and requests allowance of these claims. Additionally, Applicant submits new Claims 18-22. Applicant respectfully submits that Claims 18-22 are patentably distinct over all of the art of record and are in condition for allowance.

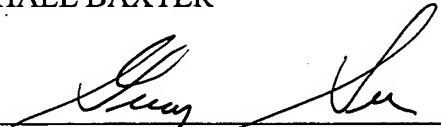
Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully submitted,  
MICHAEL BAXTER

Dated: \_\_\_\_\_

2/25/05

By: \_\_\_\_\_

  
Greg T. Sueoka, Registration No. 33,800  
Attorney fir Applicant  
Fenwick & West LLP  
Silicon Valley Center  
801 California Street  
Mountain View, CA 94041  
Tel.: (650) 335-7194  
Fax.: (650) 938-5200

20412/08085/DOCS/1491071.1